

Remarks

Claims 1, 3 and 5 have been amended. Claims 2, 4, 6 and 7 have been cancelled. Claims 1, 3, and 5 are pending.

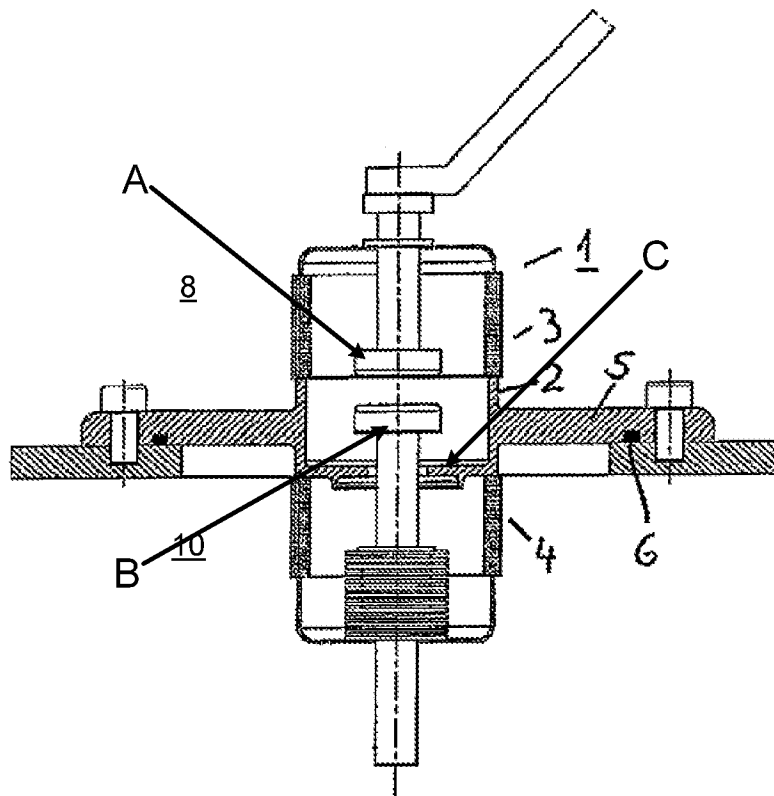
In the Office Action, the Examiner objected to the specification because of various informalities. It is believed that the attached replacement specification addresses each of the Examiner's objections.

The Examiner also objected to the drawings, asserting that, with respect to claims 1 and 3, the drawings do not adequately show the gas areas, and with regard to claim 5, that no cast resin body is shown. Figures 1 and 2 as well as the specification were amended to provide reference numerals indicating where the respective gas areas are located. Further, Figure 2 was amended to indicate that the cast resin body is shown. No new matter is presented. It is therefore believed that the Examiner's drawing objections have been overcome.

The Examiner rejected claims 1-7 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asserts that it is unclear what the three operating positions of the vacuum switch are. The Applicant respectfully disagrees with the Examiner.

A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991). The test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988) (emphasis added). The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. *In re Fisher*, 427 F.2d 833, 839 (CCPA 1970).

Three position vacuum chamber switches are well known in the art. Three position switches include a connected position, a disconnected position, and a grounding position. Par. 3. With reference to the figure below, it is well known in the art that such switches include a stationary contact (A) and a moving contact (B). The moving contact is driven up or down by a drive. Par. 3. In this manner, the moving contact (B) may be brought into contact with the stationary contact (A), may be brought into contact in the opposite direction with the metallic center part (C) which is grounded, or may be positioned in between, as shown below.



One of ordinary skill in the art would readily understand the above drawing and the operation of the three position vacuum switch without undue experimentation. Accordingly, it is believed that the Examiner's rejections under 35 U.S.C. 112, paragraph one, are believed to be improper.

The Examiner further rejected claims 5-7 under 35 U.S.C. 112, second paragraph, as being indefinite. With respect to claim 5, the Examiner asserted that "that is to say" is unclear. The Applicant has amended claim 5 to remove the objectionable language. Further, claims 6 and 7 have been cancelled. It is therefore believed that the rejections under 35 U.S.C. 112, second paragraph have been overcome.

The Examiner rejected claims 1-7 under 35 U.S.C. 102(b) as anticipated by U.S. Publication No. 2003/0094438 to Renz. The Examiner specifically asserts that Renz teaches a three-position vacuum chamber switch that forms and replaces the bushing which leads from inside the gas area to outside the gas area. The Applicant respectfully disagrees with the Examiner. There is simply no teaching within Renz that the vacuum switch forms a bushing. In fact the word bushing does not occur in the text of Renz. Accordingly, it is believed that claim 1, and the claims depending therefrom, are in condition for allowance.

As amended, claim 3 requires an edge board that extends radially outwardly and has an integrated seal. Such a feature is simply not shown in Renz. A grounding element (15) appears to extend radially outwardly (see Fig. 1), however, it does not include an integrated seal. Nor would such a feature be inherent or suggested because, as indicated above, Renz does not disclose using the switch as a bushing. Thus, no seal would be required around the grounding element (15). For these reasons, it is believed that claim 3 includes independently patentable subject matter.

The Examiner rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Ritz in view of U.S. Patent No. 4,618,749 to Bohme. The Examiner asserts that Rentz discloses each limitation in the claim except that the switching chamber includes a cast-resin body. The Examiner asserts that Bohme discloses a cast resin body and that it would have been obvious to combine the references.

As amended, claim 5 requires that the switch includes a cast-resin body to form an integrated cast-resin bushing. As discussed above, Renz does not disclose or suggest integrating the switch into a bushing. Likewise, a Bohme does not disclose or suggest the combination of the switch and bushing as taught in the present invention. In fact, the word bushing is not used once in Bohme. For these reasons, it is believed that claim 5 includes independently patentable subject matter.

The object of the bushing is normally to connect the live current paths in different gas areas and to isolate them from the grounded encapsulation. Par. 21. At the same time, the bushing can provide mechanical stability between different enclosures, and can also maintain their separation. The presently claimed invention integrates the bushing with the three position vacuum switch in a manner which minimizes complexity and overall dimensions.

Based on the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 050877.

Respectfully submitted,

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February 10, 2009